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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/785,757

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Joshua Dickinson Kraft

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02/13/2006

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EXAMINER

NGUYEN, NGA B

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/785,757

**Applicant(s)**

KRAFT, JOSHUA DICKINSON

**Examiner**

Nga B. Nguyen

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____   |

### **DETAILED ACTION**

1. This Office Action is the answer to the Amendment filed on November 11, 2005, which paper has been placed of record in the file.
2. Claims 6-10 are pending in this application.

### ***Response to Arguments/Amendment***

3. Applicant's arguments with respect to claims 6-10 have been considered but are not persuasive.

In response to the applicant's arguments that Birrell does not disclose the method of claimed doing business, examiner submit that Birrell discloses the user can download compressed audio data from a host computer onto the hard disk of the portable audio player (see column 4, lines 25-28 and column 5, lines 5-8), the host computer having a table of contents contain music titles thereby the user can download. Therefore, Birrel does disclose the business method of maintaining a database of MP3 compressed music titles enabling a purchaser to download onto the hard disk of the purchaser's portable audio player. Moreover, it is noted that the features upon which applicant relies "the purchaser may be provided access via the Internet to one or many database" are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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In conclusion, for the reason set forth above, examiner decides to maintain Birrell reference for rejection as indicated in the previous rejection and make this Office action FINAL.

4. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6-10 are ambiguous because they recites both a system and a method for using that system. See *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birrell et al (hereinafter Birrell), U.S. Patent No. 6,332,175.

Regarding to claim 6, Birrell discloses a method for providing a purchaser of a portable audio system with a library of purchaser selected music titles stored in said audio system comprising: providing a database having a plurality of music titles, each title respectively represented by stored MP3 compressed digital data; enabling said purchaser to select a set of said music titles; copying the MP3 compressed digital data representative of the set of purchaser selected music titles to a hard disk within the housing of a portable audio system being purchased by said purchaser (column 4, lines 25-28 and column 5, lines 5-8, the host computer having a table of contents contain

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music titles thereby the user can download onto the hard disk of the portable audio player).

said housing (figure 1, a portable audio player 100) further including:

at least one pair of audio output devices(column 4, lines 22-25);

means for decompressing said digital data (column 4, lines 30-37; the processing unit 102 decompresses digital data);

means for driving said output devices with said decompressed data to thereby present the music of said music titles (column 4, lines 22-25, an audio output jack 130 delivers analog audio signal to a pair of headphones); and

means for manually carrying said housing while said music is being presented (column 1, lines 10-23, the portable audio player is physically carried by the user and allows the user to listen to audio data).

Birrell discloses the hard disk drive having at least 4 gigabytes instead of 10 gigabytes. However, extending the storage capacity of a hard drive is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Birrell's by replacing the hard disk with larger storage capacity of at least 10 gigabytes for the purpose of extending the storage capacity of a hard drive, thus enabling the user can stores larger amount of MP3 compressed audio data in the portable audio player for playing back.

Regarding to claims 7 and 10, Birrell does not disclose wherein said speakers are USB speakers driven by said decompressed digital data. However, integrating USB speakers in a portable device is well known in the art. For example, speakers in

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portable radio, portable radio cassette, laptop, PDA, cellular phone, etc...Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Birrell's by replacing the headphones by speakers for the purpose of providing more convenient to the user when listening to music, because it's free the user from wearing the headphones which sometimes cause inconvenient to the user.

Regarding to claim 8, Birrell further discloses wherein said housing further includes means of converting said decompressed digital data to analog data (figure 1, a digital to analog data converter 126; column 4, lines 30-37); and wherein said means for driving said speakers drive said speaker with said analog data (figure 1, an audio output jack 130; column 4, lines 22-25).

Regarding to claim 9, Birrell further discloses wherein said housing further includes: a memory (figure 1, RAM 108, Compressed Audio Data Buffer); and means for selectively accessing the data representative of a music title form the hard drive and storing the accessed data in system memory during the audio presentation of said music title (column 5, lines 9-50).

### ***Conclusion***

9. Claims 6-10 are rejected.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on (571) 272-6799.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

C/o Technology Center 3600

Washington, DC 20231

Or faxed to:

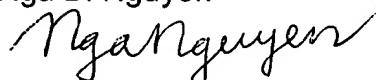
(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-0325 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Knox Building, 501 Dulany Street, Alexandria, VA, First Floor (Receptionist).

Nga B. Nguyen



February 1, 2006